



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,888	04/27/2005	Shuji Tabuchi	10873.1684USWO	2256
53148 7590 12/05/2008 HAMRE, SCHUMANN, MUELLER & LARSON P.C. P.O. BOX 2902-0902 MINNEAPOLIS, MN 55402				
EXAMINER				
BUL, LUAN KIM				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
12/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,888

Applicant(s)

TABUCHI, SHUJI

Examiner

Luan K. Bui

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 11 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Law (6,164,446). Law discloses a case (100) for holding an article comprising a bottom panel (10) having a plurality of latching members (60, 70) for latching the article, the plurality of latching members including two latching members disposed at opposite corners of the bottom panel (along sectional views IV-IV) and a release member (74) disposed at a location near one of the two latching members for releasing the latching of the article. The case of Law is inherently capable of holding a substantially rectangular cartridge having a plurality of groove portions as claimed and the release member with the one latching member are inherently capable to provide at any one of two corners defined by the pair of side faces and the rear surface of the cartridge in a state in which the cartridge has been installed.

As to claim 11, the case includes at least one pedestal (52, Figures 2 and 5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Law (6,164,446) in view of Taniyama (5,495,940). Law discloses the case (100) for holding the article as above having all of the limitations of the claims. To the degree it can be argued that Law fails to disclose the article being a substantially rectangular article (which is not positively recited in the claims), Taniyama teaches a case (25, 30, 50) for holding a substantially rectangular cartridge/article (13). It would have been obvious to one having ordinary skill in the art in view of Taniyama to modify the case of Law so the article comprises a substantially rectangular article to allow the case of Law for holding various types of articles.

5. Claims 3 and 7-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claim 1 above, and further in view of Chiu (2002/0100701). Law discloses the case as above having most of the limitations of the claims except for the release member being provided at the bottom panel so as to lift up a lower face of the article. Chiu shows a case (1-3) for holding an article comprising an engaging member (53) for engaging the article and a release member (an incline member having a finger hole 51, 52 in Figure 2) against a rear face of the article for pushing the article upward when an ear (5) is depressed. The release member disposed at the bottom panel of the case. It would have been obvious to one having ordinary skill in the art in view of Chiu to modify the release member of Law so the release member is provided at the bottom panel so as to lift up the lower face of the article to facilitate releasing the article.

As to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the case of Law so the bottom panel is square instead of the

rectangle because a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47.

As to claim 11, Chiu shows at least one pedestal (31).

6. Claims 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claim 1 above, and further in view of Deja (5,526,926). Law discloses the case as above having most of the limitations of the claims except for the release member includes an engagement release component, a pressure release component and a linking release component for releasing the article.

Deja shows a case for holding an article comprising a release member comprising an engagement release component, a pressure release component and a linking release component (12, 13, 16) for releasing the article. It would have been obvious to one having ordinary skill in the art in view of Deja to modify the case of Law so the release member comprises an engagement release component, a pressure release component and a linking release component to facilitate releasing the article. As to claim 5, Deja shows the release member (16) provided at the rear face of the article.

Response to Arguments

Applicant's arguments filed on 9/25/2008 have been fully considered but they are not deemed to be persuasive.

In response to applicant's argument that Law fails to disclose a substantially rectangular cartridge, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant's arguments with respect to claim 3 in the remarks are noted. They are not persuasive because Chiu shows the article interposed between the engaging member (53) and the release member (Figure 2).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb
December 4, 2008

/Luan K. Bui/
Primary Examiner
Art Unit 3728